

## **Remarks:**

### **Revised Office Action Has not yet been Received:**

During phone calls with Applicant around Feb 29 and March 19, 2008; Examiner Daniel Greene indicated that he had completed and was sending the Applicant a revised Office Action citing additional references and revised rejections/objections. Examiner Greene indicated there were problems/delays in getting the revised Office Action through the USPTO mail system.

So far, the Applicant has not received the revised Office Action in the mail and the revised Office-Action has not appeared in the USPTO Private-PAIR system. Without having received an revised Office Action, the Applicant believes he must respond now (within 2 months of the original Office Action) in-order to preserve Applicant's rights.

### **IDS References missing from “Applicant References Considered”:**

The IDS page that listed the patent references was missing from the Office Action's “Applicant References Considered”. Only the IDS signature page was included. Applicant believes that this page may have been unintentionally omitted from the Office Action. Applicant believes these are probably the patents that Collaborating-Examiner Ella Colbert described as the “ErinMedia patents” during first interview. Applicant respectfully requests that the references be included, so the record will be complete.

### **103(a) Rejection:**

The Office Action (on pages 6 &7) had rejected claims 101-140 under 35 USC 103(a) as being unpatentable over Admitted Prior Art (APA) in view of In re Venner, 120 USPQ 192 (CCPA 1958) and In re Rundell, 9 USPQ 220”. Specifically, the Office Action alleged that the claims are “simply automating a process previously manually done”.

The applicant respectfully traverses the rejection, for at least the following reasons, which are an alternative expression of the reasons stated in Amendment D; page 22 (amendment after the first Office Action).

The applicant believes the prior human process does not utilize the claimed elements. Applicant believes, the prior human process considers what is currently being experienced and establishes a preference; well before before taking action. The prior human process does not note the applied actions and does not utilize the applied actions to form a preference. And the prior human process does not consider the applied actions and then update the user's preference based on those applied actions.

For example, consider a user who doesn't like country music. The user may take action in-order to avoid a country music composition (e.g., “pressing the forward button” to skip the rest of a currently playing country composition). But the user did not think: “I just pressed the forward button to skip the rest of the currently playing composition ... that may mean I don't like that composition ... therefore I should lower my preference for that composition because I pressed that button”. In reality, the user had established his preference before taking that action (e.g., before “pressing the forward button”). In the prior human process, the user did not utilize the applied actions in-order to determine or update their preference.

Hence, in claims 101 and 121; both the second (“capturing”) and third (“updating”) claim elements are not done by the prior human process. The prior human process does not utilize the user's applied actions to determine or update a preference. Therefore, for at least the above reasons, claims 101 and 121 are not an automation of a currently performed human process.

That the Examiner did not previously appreciate the differences between the prior human process and the Applicant's invention may be considered additional proof that the Applicant's invention is not obvious.

These above arguments also apply to the independent apparatus claim. These above arguments may also be applied to the dependent claims. In addition, because the dependent claims are based upon the elements of the independent claims that have not been done by the prior human process; the dependent claims differ from from the prior human process.

### **101 Rejection:**

The Office Action (on page 5) had rejected claims 101-140 under 35 USC 101 for being directed to non-statutory subject matter; specifically that “the claims do not explicitly set forth that a computer network or a machine is performing all the steps necessary to perform said method”.

The applicant respectfully traverses the rejection, for at least the following reasons.

a) Applicant believes that a claim for a set of elements that are new and which create a useful end-result is patentable subject matter; even if they are manually performed. It not required that they be performed by a “computer or a machine” in-order to be patentable subject matter.

b) Based on at least the same reasons given above in response to the 103(a) rejection, the applicant believes the claimed elements as a whole have not been performed by a prior human process.

Therefore, the applicant believes the claims are patentable even if they were to be manually performed by a human. Note however, that the word “automatically” is in the independent claims.

#### **CFR 1.75 Objection for “Substantial Duplicate” Claims:**

The Office Action (on pages 4 and 5) had under 37 CFR 1.75 objected to claims 121-139 as being “a substantial duplicate” of claims 101-120.

The applicant respectfully traverses the rejection, for at least the following reasons. The 4<sup>th</sup> element in the original 121 is significantly different from the 4<sup>th</sup> element of original claim 101. Since the independent claim 121 is not “a substantial duplicate” of independent claim 101; then dependent claims 122-139 are also not “substantial duplicate”. Hence, applicant believes the dependent claims 122-139 would be allowable even if they remain dependent on parent claim 121.

However, the applicant would like to thank the Examiner for prompting the applicant to consider this. Because, the applicant now recognizes that a more diverse infringement protection will be obtained by having one set of dependent claims under an independent method claim (101) and another set of dependent claims under an independent apparatus claim.

Therefore, the second set of dependent method claims (122 to 139) have been canceled.  
Independent apparatus claim 140 has been canceled. A new (clearer) independent apparatus claim 141 has been added. New dependent claims have added under the new independent apparatus claim 141.

#### **Double Patenting:**

The Office Action (on page 4) described Double Patenting. The applicant respectfully traverses the rejection, for at least the following reasons. The Office Action did not specifically identify two

different patents or applications that were alleged to be claiming the “same invention”.

### **112 Rejections for being “Indefinite”:**

(a) The Office Action (on page 3 & 4) had rejected claims 101, 121 and 140 under 35 USC 112 for being indefinite because a “sequence is never provided by the claim”.

The preamble of the independent claims has been changed to the broader phrase: “personalized music or entertainment”.

(b) The Office Action (on page 4) had rejected claims 101, 121 and 140 under 35 USC 112 for insufficient antecedent basis (for the use of “said” in the second element).

The antecedent has been clarified.

### **Claim Objections Informalities:**

The Office Action (on page 3) objected to claim 121 for informalities, specifically, for not beginning each method claim element with an action word ending in “ing”.

The applicant respectfully traverses the rejection, for at least the following reasons. The applicant is not aware of and the Office Action does not cite a USC; CFR; MPEP or Court-Ruling that specifically requires the first word of each element in a method claim to begin with an action word ending in “ing”.

However, the applicant has re-arranged claim 121 so that each element begins with an action word ending in “ing”. The applicant believes the meaning of the claim has not changed by moving the “ing” word or phrase to the beginning of each element.

### **Asserted Admission of Prior Art (Office Action page 2):**

The Office Action asserted an “Admission of Prior Art under MPEP 2144.03[R-1] C”. The applicant respectfully traverses this assertion made in the Office Action for at least the following reasons. Applicant believes he did traverse the iTunes and iPod in his response to the first Office Action (Amendment D). In particular, the iTunes and iPod were traversed and discussed in detail in

Amendment D: on page 17 (paragraphs 2 and 3); and in significant portions of the text on pages 19, 20 and 21.

**Summary:**

The independent method claim 101 has been amended. Dependent claims 106-120 have been amended into a simpler and clearer form.

The independent method claim 121 has been amended. Dependent claims 122 to 139 have been canceled.

Independent apparatus claim 140 has been canceled. A clearer, new independent apparatus claim 141 has been added. New apparatus dependent claims 142 to 159 have been added.

The number of independent claims and total claims in the application are unchanged.

The applicant believes all the claims are in condition for allowance. The applicant respectfully requests that a timely Notice of Allowance be issued in this case. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the Applicant.

Respectfully submitted,

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